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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,416	03/29/2001	David Bar-Or	4172-15-1	5597

22442 7590 03/08/2002

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EXAMINER

SHAHNAN SHAH, KHATOL S

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 03/08/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,416

Applicant(s)

BAR-OR ET AL.

Examiner

Khatol S Shahnan-Shah

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001 and 14 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 48-101 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Applicant's preliminary amendment received 7/27/2001, paper # 7 is acknowledged. Claims 1-47 were canceled. New claims 48-101 were added.
2. Information disclosure statement, received 11/14/2001, paper # 8 is acknowledged.
3. Currently claims 48-101 are pending.

Restriction

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 48-68 are, drawn to a method of monitoring treatment of disease with a compound that produces or reduces free radical damage by quantifying the presence of the marker, albumin, classified in class 435 subclass 7.1.
 - II. Claims 69-75 are, drawn to a method of monitoring a compound that produces or reduces free radical damage by detecting the amount of copper ion, classified in class 436 subclass 41.
 - III. Claims 76-93 are, drawn to a method of monitoring or assessing a disease by quantifying the presence of the marker, albumin classified in class 436 subclass 88.
 - IV. Claims 94-97 are, drawn to a method of monitoring or assessing a disease by detecting the amount of copper ion, classified in class 436 subclass 80.
 - V. Claims 98-99 are, drawn to a method of monitoring or

assessing a disease by obtaining multiple samples classified in class 436 subclass 43.

VI. Claims 100-101 are, drawn to a method of detecting free radicals from a Tissue classified in class 436 subclass 74.

5. The inventions are distinct, each from the other because of the following reasons:

Groups I-VI are drawn to different methods, which differ in method objectives, method steps and material used.

The several inventions above have acquired a separate status in the art because of their recognized divergent subject matter, independent search requirement and additionally it would be an undue burden on the examiner to search all of the groups, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Election

7. This application contains claims directed to the following patentably distinct species of the claimed invention:

a- If applicants elect group I, then there are additional election of species.

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Please choose one of the species (produce or reduce) from claim 48.

Please choose one of the species (free radical scavengers) from claim 50.

Please choose one of the species (samples) from claims 53 or 54.

Please choose one of the species (metal ion salts) from claims 55-57 and 66-68.

Please choose one of the species (assays) from claims 59-62.

b- If applicants elect group II, then there are additional election of species.

Please choose one of the species (produce or reduce) from claim 69.

Please choose one of the species (free radical scavengers) from claim 71.

Please choose one of the species (assays) from claims 74-75.

c- If applicants elect group III, then there are additional election of species.

Please choose one of the species (treatments) from claim 77.

Please choose one of the species (samples) from claims 78 or 79.

Please choose one of the species (metal ion salts) from claims 81-82 and 91-93.

Please choose one of the species (assays) from claims 86-87 and 89-90.

The species are shown to be distinct because they are drawn to a plurality of disclosed patentably distinct methods and compounds comprising different method steps and structurally and functionally distinct molecules.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Claims 48, 76, 94, 98-101 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khatol Shahnan-Shah whose telephone number is (703) 308-8896. The examiner can normally be reached on 7:30 AM - 4 PM from Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F Smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned to is (703) 305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

 -3/6/02

Khatol Shahnan-Shah, BS, Pharm, MS

Biotechnology Patent Examiner


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
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